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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,284	02/15/2002	Serge Vanhaelemeersch	IMEC238.001AUS	3438
20995	7590	12/15/2003		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER	
			ESTRADA, MICHELLE	
			ART UNIT	PAPER NUMBER
			2823	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,284	VANHAEMEERSCH ET AL.	
	Examiner	Art Unit	
	Michelle Estrada	2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 1-15) in Paper filed 11/17/03 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description in the specification as originally filed of what kind of combination of gases would lead to the resultant structure generically. Chemical reactivity is a most unpredictable and empirical art and it is well settled that the requirement that the claims be commensurate in scope with the enabling disclosure is particularly stringent in this area of technology. In re Doumani 126 USPQ 408, In re Grant 134 USPQ 248, In re Fisher 166 USPQ 18, Mobil Oil Corporation v. W. R. Grace and Company 180 USPQ 418, In re Slocombe 184 USPQ 740, In re Mercier 185 USPQ 774, Corona Cord Tire Company v. Dovan Chemical Corporation 192 CD

255, See *In re Hawkins* 174 USPQ 157 (pg. 163) reasoning is sufficient, evidence is not required.

There is seen only description of the species wherein the components are selected from the groups disclosed in instant page 18.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the species of forming an opening in an insulating layer on a substrate using gases selected from the groups disclosed in instant page 18, does not reasonably provide enablement for what kind of combination of gases would lead to the resultant structure generically. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. There is no description in the specification as originally filed of what kind of combination of gases would lead to the resultant structure as discussed above and therefore insufficient guidance to enable one of ordinary skill in the art to determine suitable combination of gases to achieve the instant invention. Chemical reactivity is a most unpredictable and empirical art and it is well settled that the requirement that the claims be commensurate in scope with the enabling disclosure is particularly stringent in this area of technology. *In re Doumani* 126 USPQ 408, *In re Grant* 134 USPQ 248, *In re Fisher* 166 USPQ 18, *Mobil Oil Corporation v. W. R. Grace and Company* 180 USPQ 418, *In re Slocombe* 184 USPQ 740, *In re Mercier* 185 USPQ 774, *Corona Cord Tire Company v. Dovan Chemical Corporation* 192 CD 255, See *In re Hawkins* 174 USPQ 157 (pg. 163) reasoning is

sufficient, evidence is not required. For example, claim 2 recites different gases suitable as the first component, claim 3 recites different gases suitable as the second component and claim 4 recites different gases suitable as the third component, however, there is no guidance of how one of ordinary skill in the art would pick and choose a combination of these gases and the other required gases to enable formation of the resultant structure. In particular, it is not obvious from the disclosed species what other species will work. More specifically, there is lack of predictability in the art because one skilled in the art cannot readily anticipate the effect of a change in the gases used on the behavior of the combination of gases in a plasma environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Estrada whose telephone number is (703) 308-0729 or (571) 272-1858. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794 or 571-272-1855. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Art Unit: 2823

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



MEstrada

December 11, 2003



G. K. Chen

Supervisory Patent Examiner
Technology Center 2800